



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,352	02/02/2004	Carl E. Whitcomb	WHIT0002.A	7661
24945	7590	10/07/2009	EXAMINER	
STREETS & STEELE 13831 NORTHWEST FREEWAY SUITE 355 HOUSTON, TX 77040			NGUYEN, SON T	
ART UNIT	PAPER NUMBER		3643	
MAIL DATE	DELIVERY MODE			
10/07/2009	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/770,352	Applicant(s) WHITCOMB, CARL E.
	Examiner Son T. Nguyen	Art Unit 3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 June 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3,5-54 and 63-74 is/are pending in the application.
 4a) Of the above claim(s) 41-45 and 51-54 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3,5-40,46-50,63-74 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 17 June 2009 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

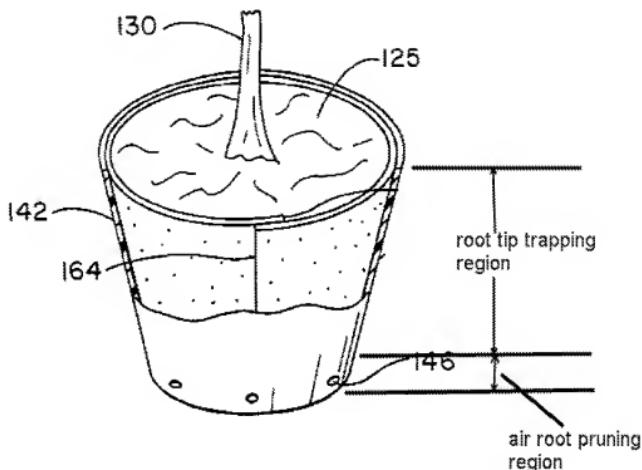
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. **Claims 1,2,7,37 are rejected under 35 U.S.C. 102(a) as being anticipated by Reiger (6202348).**

For claim 1, Reiger teaches a sidewall for a plant container, comprising: a substantially water-impermeable root-tip-trapping region (wall 142 and liner 120 together trap root tips 184 as stated in col.7,lines 42-62,col. 8,lines 28-49, and also see illustration below for regions); and a porous air-root-pruning region (drain holes 146 at bottom portion of the sidewall that are exposed to air to which the adjacent fabric liner inherently performs the air root pruning function, and also see illustration below for regions) adjacent the root-tip-trapping region, wherein the root-tip-trapping region is a contiguous upper portion of the sidewall (there are no breaks or interruption in the sidewall for the root tip trapping region, hence, contiguous) and the air-root-pruning region is a contiguous lower portion of the sidewall (there are no breaks or interruption in the sidewall for the air root pruning region, hence, contiguous). Note also the Board's decision filed 6/13/08, page 8.



For claim 2, Reiger teaches wherein the root-tip-trapping region is colinear with the air-root-pruning region (as shown in the illustration above, the air root pruning region comes right after (in a linear sequence) the root tip trapping region).

For claim 7, Reiger teaches wherein the sidewall is flexible, rigid, or a combination thereof (the liner 120 is flexible and the pot wall 142 is rigid, thus, the sidewall as a whole is a combination of both flexible and rigid).

For claim 37, Reiger teaches wherein the sidewall is an integral part of a container (as in the whole unit assembly).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3,12,14-20,26,27,32,33,46-50,63,64,67,68 are rejected under 35

U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Reynolds et al. (3080680).

For claims 3,67, Reiger teaches wherein the root-tip-trapping region comprises a porous fabric layer 120 snugly placed into a layer of a root-impenetrable material 142. "Snugly", technically, fits the definition of bond because, according to www.dictionary.com, the word bond can mean something that binds, fastens, confines or holds together.

In the event that Applicant believes that snugly does not fit the definition of bond, then Reynolds et al. teach in the same field of endeavor of a sidewall for a plant container as Reiger, in which Reynolds' sidewall includes a root-tip-trapping region comprises a porous fabric layer 18 bonded to a layer of a root-impenetrable material 60,62 (col. 2,lines 47-52,col. 6,lines 3-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the layers as taught by Reynolds of the sidewall of Reiger in order to secure the layers together but yet allow the user to remove the outer layer or the root impenetrable material as desired such as in the case for transplanting. Note that Reynolds also teaches snugly, col. 2,lines 61-62.

For claim 12, Reiger as modified by Reynolds et al. further teaches wherein the root-impenetrable material is water- impermeable (col. 3,lines 28-29,63-65, inherently

taught in Reiger because if not water-impermeable, why would Reiger discloses drain holes).

For claims 14-15, Reiger as modified by Reynolds et al. is silent about wherein the porous fabric has a weight between 2 and 10 or 4 and 6 ounces per square yard. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous fabric of Reiger as modified by Reynolds et al. with a weight between 2 and 10 or 4 and 6 ounces per square yard, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art. Note that Reiger does teach weight in ounces in col. 9,lines 1-5.

For claim 16, Reiger as modified by Reynolds et al. is silent about wherein the porous fabric has openings between 1/16 and 1/4 inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous fabric of Reiger as modified by Reynolds et al. with openings between 1/16 and 1/4 inch, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect (depending on the plant root sizes) is achieved involves only routine skill in the art.

For claim 17, Reiger as modified by Reynolds et al. teaches wherein the porous fabric is a spun bonded, needle punched fabric (col. 9,lines 6-15 of Reiger).

For claim 18, Reiger as modified by Reynolds et al. teaches wherein the porous fabric is selected from polyesters, polypropylene or other olefin fiber (col. 9, lines 6-15 of Reiger).

For claim 19, Reiger as modified by Reynolds et al. teaches wherein the porous fabric is a woven or knitted fabric (col. 8, lines 64-67, col. 9, lines 1-15 of Reiger).

For claim 20, Reiger as modified by Reynolds et al. teaches wherein the porous fabric is degradable (col. 8, lines 64-67, col. 9, lines 1-15 of Reiger).

For claims 26-27, Reiger teaches the root impenetrable material is plastic (col. 3, line 29) but is silent about the material being a polymer sheet selected from polyethylene and polypropylene.

As mentioned above, Reynolds et al. teach a polymer sheet 60,62 selected from polyethylene and polypropylene (col. 5, lines 5-7) for covering the porous fabric layer 18. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the root impenetrable material of Reiger as modified by Reynolds et al. out of a polymer sheet selected from polyethylene and polypropylene as further taught by Reynolds et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

For claims 32-33, Reiger as modified by Reynolds et al. is silent about the root-impenetrable material having a thickness between 2 and 10 mils or 3 and 5 mils. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root-impenetrable material of Reiger as modified by Reynolds et

al. with a thickness between 2 and 10 mils or 3 and 5 mils, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable value/ranges until the desired effect is achieved involves only routine skill in the art.

For claims 46,68, Reiger as modified by Reynolds et al. teach wherein the porous fabric layer 120 of the root tip trapping region (as shown in the illustration above) extends beyond the layer of root impenetrable material (at the drain holes 146) to form the porous air root pruning region. Note that the liner 120 extends or covers the drain holes. The drain holes are where the layer of root impenetrable material does not exist, thus, the liner 120 does extends beyond the root impenetrable material in the areas of the drain holes.

For claim 47, see claim 17 above.

For claim 48, see claim 14 above.

For claim 49, see claim 26 above. Reiger teaches the porous fabric being spun bonded fabric as stated above, and Reynolds et al. teach the polyethylene sheet for the root impenetrable layer as stated above.

For claim 50, see claims 26,32 above.

For claim 63, Reiger as modified by Reynolds et al. teach wherein the porous fabric layer 120 of the root tip trapping region (as shown in the illustration above) extends beyond the layer of root impenetrable material (at the drain holes 146) to form the porous air root pruning region. Note that the liner 120 extends or covers the drain holes. The drain holes are where the layer of root impenetrable material does not exist,

thus, the liner 120 does extends beyond the root impenetrable material in the areas of the drain holes.

For claim 64, Reiger as modified by Reynolds et al. is silent about wherein the layer of root impenetrable material is disposed over 1/2 to 9/10 of the porous fabric layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the layer of root impenetrable material be disposed over 1/2 and 9/10 of the porous fabric layer of Reiger as modified by Reynolds et al., depending on the type of plant being grown because different plants might need different air root pruning, thus, if a plant needs less air root pruning, then the sidewall would be made more of root tip trapping region than air root pruning region.

5. Claims 5,6,13,65,66,69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger (as above).

For claims 5-6, Reiger is silent about wherein the root-tip-trapping region comprises between 1/2 and 9/10 or 2/3 and ¾ of the sidewall. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root-tip-trapping region comprises between 1/2 and 9/10 or 2/3 and ¾ of the sidewall of Reiger, depending on the type of plant being grown because different plants might need different air root pruning, thus, if a plant needs less air root pruning, then the sidewall would be made more of root tip trapping region than air root pruning region.

For claim 13, Reiger is silent about wherein the root-tip-trapping region comprises greater than 10 root-tip-trapping elements per square inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made

to have the root-tip-trapping region of Reiger comprising greater than 10 root-tip-trapping elements per square inch, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect (depending on how much root tip one wishes to trap) is achieved involves only routine skill in the art.

For claims 65-66, the limitation as claimed has been explained in the above, thus, please see above.

For claim 69, Reiger teaches the regions are configured in a pattern of rows as shown in the illustration above. The drain holes constituting the air root pruning region is in a row and the root tip trapping region is in a row up from the drain holes.

6. Claims 8,9,11,36,38-40,70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Whitcomb et al. (4939865).

For claim 8, Reiger teaches air-root-pruning region (see illustration above, the liner covers the holes 146) form a bendable sheet (the liner is bendable sheet). However, Reiger is silent about wherein the root-tip-trapping form a bendable sheet.

Whitcomb et al. teach in the same field of endeavor of a sidewall for a plant container as Reiger, in which Whitcomb et al.'s sidewall includes sheets of material that are bendable to form a container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root tip trapping region of Reiger be formed from a bendable sheet as taught by Whitcomb et al. in order to allow

a user the flexibility to form the container into a selected size as desired (col. 2,lines 15-18).

For claim 9, Reiger is silent about wherein the air-root-pruning region includes protuberances having outwardly extending distal ends that are open.

Whitcomb et al. teach in the same field of endeavor of a sidewall for a plant container as Reiger, in which Whitcomb et al.'s sidewall includes protuberances 20,22 having outwardly extending distal ends 18 that are open. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have protuberances having outwardly extending distal ends that are open as taught by Whitcomb et al. in the air-root-pruning region of Reiger in order to direct the roots to the holes for a quicker air pruning (Whitcomb et al., col. 2,lines 27-29).

For claim 11, Reiger teaches the porous fabric layer or liner 120 of the sidewall being sewn together at its edges (see fig. 10 and col. 8,lines 4-7). However, Reiger is silent about the layer of root impenetrable material 142 being secured at its edges.

Whitcomb et al. teach in the same field of endeavor of a sidewall for a plant container as Reiger, in which Whitcomb et al.'s sidewall includes sheets of material that are bendable to form a container. The sheets forming the container are connected by hooking edges of the sheet together with tenons 28 and mortises 30. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root tip trapping region of Reiger be formed from a bendable sheet as taught by Whitcomb et al. and to hook the edges of the sheet as further taught by Whitcomb et

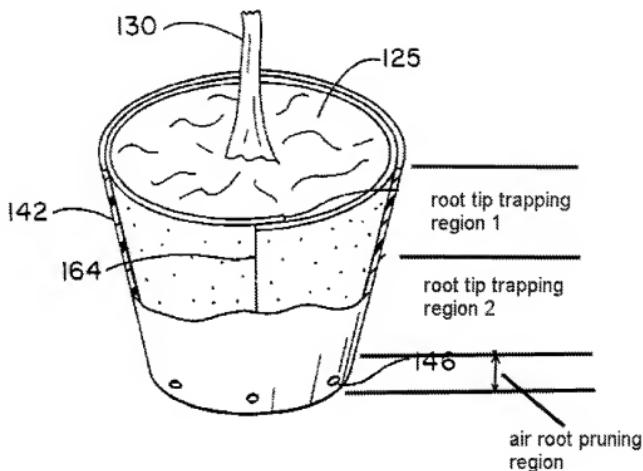
al. together, in order to allow a user the flexibility to form the container into a selected size as desired (col. 2,lines 15-18).

For claim 38, as mentioned above, Whitcomb et al. teach wherein the sidewall is a discrete panel that can form a container. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sidewall of Reiger be a discrete panel that can form a container as taught by Whitcomb et al., in order to allow a user the flexibility to form the container into a selected size as desired and easier for assemblage/disassemblage (col. 2,lines 15-18).

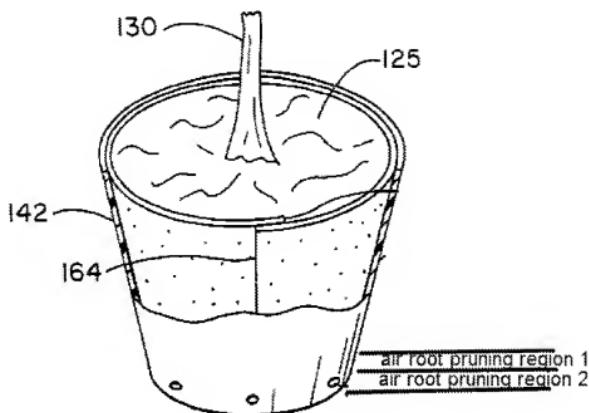
For claim 70, the limitation has been explained, thus, please see above, especially claims 1 & 8.

For claim 36, the limitation has been explained, thus, please see above, especially claim 69.

For claim 39, since there is no boundary defined in Applicant's invention regarding regions, the examiner is considering the regions as illustrated below as taught by Reiger as modified by Whitcomb et al. (emphasis on Reiger).



For claim 40, since there is no boundary defined in Applicant's invention regarding regions, the examiner is considering the regions as illustrated below as taught by Reiger as modified by Whitcomb et al. (emphasis on Reiger).



For claims 71-72, the limitation has been explained, thus, please see above, especially claim 5.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Whitcomb et al. (4716680).

For claim 10, Reiger is silent about wherein the root-tip-trapping region includes protuberances having outwardly extending distal ends that are closed to trap roots.

Whitcomb et al. teach in the same field of endeavor of a sidewall for a plant container as Reiger, in which Whitcomb et al.'s sidewall includes protuberances 52,54,56,60,62 having outwardly extending distal ends 56,58 that are closed to trap roots. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to have protuberances having outwardly extending distal ends that are closed to trap roots as taught by Whitcomb et al. in the root-tip-trapping region of Reiger in order to prevent spiral root growth and to maximize development of lateral root tips along and around the sides of the container (Whitcomb et al., col. 2,lines 60-65).

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1,3 above, and further in view of Thomas (5311700).

For claim 21, Reiger as modified by Reynolds et al. is silent about wherein the porous fabric is cotton.

Thomas teaches a sidewall for a container wherein he employ a porous fabric made out of cotton (col. 5, line 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ cotton as taught by Thomas as the preferred porous fabric in the container of Reiger as modified by Reynolds et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (biodegradability for friendlier to the environment) as a matter of obvious choice

9. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1,3 above, and further in view of Berlit et al. (GB 2073567).

For claims 22-23, Reiger as modified by Reynolds et al. is silent about wherein the porous fabric is opaque, black or gray.

Berlit et al. teach a sidewall for a container wherein they employ an opaque or black material to prevent light from harming the roots (page 1, lines 100-105). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an opaque or black material as taught by Berlit et al. in the container of Reiger as modified by Reynolds et al. in order to prevent light from harming the roots.

For claim 24, Reiger as modified by Reynolds et al. (emphasis on Reynolds et al. since they are relied on for the bonding of the porous fabric and the root impenetrable material) teaches the porous fabric adheres to the root impenetrable material as explained in the above. However, Reiger as modified by Reynolds et al. did not specify if the bonding is by a method selected from gluing, laminating and combinations thereof.

In addition to the above, Berlit et al. teach a plurality of layers laminated to make the container. It would have been an obvious substitution of functional equivalent to substitute the bonding method of Reiger as modified by Reynolds et al. to bond the porous fabric with the root impenetrable material with the bonding method of laminating as taught by Berlit et al., since a simple substitution of one known element for another would obtain predictable results. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

10. Claims 25,29,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1,3 above, and further in view of Van der Goorbergh (EP 300578A3).

For claims 25,29, Reiger as modified by Reynolds et al. is silent about wherein the root-impenetrable material is reflective such as a metal foil.

Van der Goorbergh teaches a container having metal foil material (aluminum foil), which is a reflective material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a metal foil material as taught by van der Goorbergh for the root impenetrable material in the container of Reiger as modified by Reynolds et al. in order to reflect harmful light away from the plant.

For claim 31, Reiger as modified by Reynolds et al. is silent about wherein the root-impenetrable material is white.

In addition to the above, van der Goorbergh teaches the root- impenetrable material 6 being white (col. 2, line 55 & col. 3, line 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a white polymer sheet as taught by van der Goorbergh as the preferred material for the root-impenetrable material of Reiger as modified by Reynolds et al. in order to reflect harmful light away from the plant (col. 2, lines 54-55 of van der Goorbergh).

11. Claims 28,34,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. as applied to claims 1,3 above, and further in view of Flasch (5852896).

For claim 28, Reiger as modified by Reynolds et al. is silent about wherein the root-impenetrable material is metal.

Flasch teaches a sidewall for a container comprising a root- impenetrable material 6 made out of metal (col. 12, line 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ metal as

taught by Flasch as the preferred root-impenetrable material of Reiger as modified by Reynolds et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

For claims 34-35, Reiger as modified by Reynolds et al. is silent about wherein the root-impenetrable material is biodegradable.

In addition to the above, Flasch also states that the container's root-impenetrable material 6 made out of wood (col. 12, line 38), which wood is biodegradable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ wood as taught by Flasch as the preferred root-impenetrable material of Reiger as modified by Reynolds et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (better for the environment) as a matter of obvious choice.

12. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Reynolds et al. and Berlit et al. as applied to claims 1,3,22 above, and further in view of Flasch (as above).

For claim 30, Reiger as modified by Reynolds et al. and Berlit et al. is silent about wherein the root-impenetrable layer is pervious to UV radiation.

In addition to the above, Flasch teaches using a UV inhibitor to provide UV light stability (col. 12, line 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a UV inhibitor as taught by Flasch in

the root impenetrable material of Reiger as modified by Reynolds et al. and Berlit et al. in order to block out harmful UV radiation.

13. Claims 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Whitcomb et al. as applied to claim 70 above, and further in view of Reynolds et al. (as above).

The limitations have been explained in the above, thus, please see above, especially claims 3,46.

Response to Arguments

14. Applicant's arguments filed 6/17/09 have been fully considered but they are not persuasive.

Applicant argued that the examiner's assertion via the figure on page 5 of the Office Action extrapolates the discrete drain hole regions of Reiger into an arbitrary zone that is unsupported by Reiger. The examiner's annotation of the Reiger's figure 8 to show the arbitrary air root pruning region is the result of impermissible hindsight reasoning. There is no valid basis for the examiner's finding.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In addition, according to a definition of the word "region", a region is a large, usually continuous segment of a surface or space; area (www.dictionary.com). Based on this definition, one can see clearly that Reiger teaches, in his drawings, regions where the root tip trapping exist and the air root pruning exist as shown in the above illustration. It is not hindsight reasoning when a reference such as Reiger clearly teaches the broad claim limitation of "a region".

Applicant argued that claim 1 includes the limitation that the air-root-pruning region is a contiguous lower portion of the sidewall. One example of an air-root-pruning region that is a contiguous lower portion of the sidewall is shown as region 20 in Figure 1 of the present application. The word "contiguous" is used in its ordinary sense to mean touching or connected throughout in an unbroken sequence. Reiger' s drain hole regions are, in fact, a plurality of discrete and separate regions that are not contiguous.

The definition given by Applicant is just one definition of contiguous, and it is not the only definition in its ordinary sense because there are other definitions of the word contiguous that are used in its ordinary sense to mean "adjacent or neighboring" (www.dictionary.com). Based on "adjacent or neighboring" definition of contiguous, the region where the drain holes are located in Reiger is a contiguous lower portion of the sidewall.

Applicant argued that the specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the

meaning of a claim term when an applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification. See Phillips v. AWH Corp., 363 F.3d 1207, 75 USPQ2d 1321 (Fed. Cir. 2005)(en banc); and Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1583 USPQ2d 1573, 1577 (Fed. Cir. 1996).

Applicant's specification does not fully explained further detail about the word "contiguous" as argued. The original specification never even employed the word "contiguous". The amended specification filed 6/17/09 made changes to replace "continuous" with ---contiguous--- and that is about it. If it is the point of argument here, which it appears that all Applicant is arguing is this "contiguous" term, then the specification must contain more detail to explain further of this term. Otherwise, yes applicant can be his own lexicographer, but if applicant failed to further expand on the meaning of a term that applicant wishes the examiner to give weight, then applicant must explained so in the specification. Note that the term "contiguous" is not "special" or art related term, so even if applicant fully explained such term in applicant's context of usage, the general definition stills hold.

Applicant argued that with respect to claim 64, the examiner states that it would be obvious to have the layer of root impenetrable material disposed over 1/2 to 9/10 of the porous fabric layer of Reiger as modified by Reynolds et al., "depending on the type of plant being grown because different plants might need different air root pruning, thus, if a plant needs less air root pruning, then the

sidewall would be made more of a root tip trapping region than air root pruning region." (Office Action dated March 17, 2009, page 10, lines 3-8). The examiner has failed to recite any basis for these assertions and appears to be taking official notice. Applicant respectfully requests that the examiner provide support for the premise that "different plants might need different air root pruning.

The examiner is not taking office notice as alleged by applicant, thus, it is uncertain where applicant derived at this conclusion? Clearly, the examiner is providing common sense articulated rational using case law in *re KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007). This is not the same as taking office notice.

Applicant argued that regarding claims 5, 6, 65 and 66, the examiner states that it would be obvious to have the root-tip-trapping region comprise between 1/2 and 9/10 or between 2/3 and ¾ of the sidewall of Reiger, "depending on the type of plant being grown because different plants might need different air root pruning, thus, if a plant needs less air root pruning, then the sidewall would be made more of a root tip trapping region than air root pruning region." (Office Action dated March 17, 2009, page 10, lines 3-8). The examiner has failed to recite any basis for these assertions and appears to be taking official notice. Applicant respectfully requests that the examiner provide support for the premise that "different plants might need different air root pruning."

The examiner is not taking office notice as alleged by applicant, thus, it is uncertain where applicant derived at this conclusion? Clearly, the examiner is providing

common sense articulated rational using case law in re KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007). This is not the same as taking office notice.

Applicant argued that claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as applied to claim 1 above, and further in view of Whitcomb et al. (4716680). There is no suggestion to combine Reiger and Whitcomb because these references both assert to trap roots achieve the benefits of preventing spiral root growth and maximizing development of lateral roots, if Reiger discloses root trapping, why would Reiger suggest using some other means to trap roots.

Reiger teaches root trapping; however, the root trapping material employed by Reiger does not have protuberances having outwardly extending distal ends that are closed to trap roots. Hence, the examiner relied on Whitcomb et al. for a teaching of a sidewall for a plant container, in which Whitcomb et al.'s sidewall includes protuberances 52,54,56,60,62 having outwardly extending distal ends 56,58 that are closed to trap roots. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have protuberances having outwardly extending distal ends that are closed to trap roots as taught by Whitcomb et al. in the root-tip-trapping region of Reiger in order to prevent spiral root growth and to maximize development of lateral root tips along and around the sides of the container (Whitcomb et al., col. 2,lines 60-65).

Applicant argued that the examiner relies upon his previous explanations of claim 3 and 46 as support the rejection. However, it should be realized that claims 73-74 depend from independent claim 70, whereas claims 3 and 46 depend from independent claim 1. Still further, even the examiner's rejection of claim 70 relies upon the rejection of claims 1 and 8. The rejection relies so heavily upon prior statements that it is difficult to understand. Accordingly, the Applicant asserts that the examiner has not provided a clear statement of the rejection that enables an adequate response.

Claim 70 claims the same subject matter as claims 1 & 8, thus, the same explanation for claims 1 & 8 from the above should applied to claim 70. The examiner believes that this is clear enough without having to discuss the same again because one of ordinary skill in the art would know in reading claims 1 & 8 that they are similar to claim 70. However, the examiner copied and pasted claims 1 & 8 below for applicant's reference. Note that claim 70 claims the same subject matter.

For claim 1, Reiger teaches a sidewall for a plant container, comprising: a substantially water-impermeable root-tip-trapping region (wall 142 and liner 120 together trap root tips 184 as stated in col.7,lines 42-62,col. 8,lines 28-49, and also see illustration below for regions); and a porous air-root-pruning region (drain holes 146 at bottom portion of the sidewall that are exposed to air to which the adjacent fabric liner inherently performs the air root pruning function, and also see illustration below for regions) adjacent the root-tip-trapping region, wherein the root-tip-trapping region is a contiguous upper portion of the sidewall (there are no breaks or interruption in the

sidewall for the root tip trapping region, hence, contiguous) and the air-root-pruning region is a contiguous lower portion of the sidewall (there are no breaks or interruption in the sidewall for the air root pruning region, hence, contiguous). Note also the Board's decision filed 6/13/08, page 8.

For claim 8, Reiger teaches air-root-pruning region (see illustration above, the liner covers the holes 146) form a bendable sheet (the liner is bendable sheet). However, Reiger is silent about wherein the root-tip-trapping form a bendable sheet.

Whitcomb et al. teach in the same field of endeavor of a sidewall for a plant container as Reiger, in which Whitcomb et al.'s sidewall includes sheets of material that are bendable to form a container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root tip trapping region of Reiger be formed from a bendable sheet as taught by Whitcomb et al. in order to allow a user the flexibility to form the container into a selected size as desired (col. 2,lines 15-18).

All other arguments in regard to the dependents are the same as the above, thus, see above response.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son T. Nguyen/
Primary Examiner, Art Unit 3643